

REMARKS/ARGUMENTS

Re-examination and favorable reconsideration in light of the above amendments and the following comments are respectfully solicited.

Claims 10 - 19 are pending in the application. Currently, all claims stand rejected.

In the office action of April 11, 2005, claims 10 - 19 were rejected under 35 U.S.C. 112, first paragraph as being non-enabled; claims 10 - 13 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,722,099 to Kratz; claims 14 - 16 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kratz in view of U.S. Patent No. 5,593,754 to Blauer et al.; and claims 17 - 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kratz in view of U.S. Patent No. 2,002,955 to Lipson.

The foregoing rejections are traversed by the present response.

The present invention relates to a garment to be worn by a human being which comprises a front portion and a rear portion and a pair of arms being joined to the front and rear portions. Each of the arms has an outer elbow portion formed from a stretch fabric material and other portions formed from a non-

stretch fabric material. The garment further has underarm portions formed from a stretch fabric material.

With respect to the rejection of claims 10 - 19 under 35 U.S.C. 112, first paragraph, it is the Examiner's position that the specification, while being enabling for defining a non-stretch material, does not reasonably provide enablement for defining a non-stretch fabric material. The Examiner contends that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected to define the invention commensurate in scope with these claims. The Examiner contends that the specification does not define what the non-stretch material is made of.

It is Applicant's position that the rejection of claims 10 - 19 under 35 U.S.C. 112, first paragraph is improper and should be withdrawn. The enablement requirement of 35 U.S.C. 112, first paragraph, does not require an applicant to disclose and explain that which is commonly used and well known in the art. See *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). The enablement requirement is set forth in the first paragraph of section 112 of Title 35, U.S.C. which provides in pertinent part that the specification shall describe "the manner and process of making and using [the invention], in such clear and concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use [the invention]." 35 U.S.C. §112, ¶1 (2000). The case law holds that the enablement requirement is satisfied when one

skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation. See *In re Wands*, 858 F.2d 731, 736-37, 8 USPQ2d 1400 (Fed. Cir. 1988).

The term "non-stretch fabric material" used in the specification and claims is a term of art that would be well understood by those skilled in the art. It is known in the art that certain woven fiber materials are "non-stretch fabric materials". To demonstrate the usage of the term "non-stretch fabric material", Applicant has provided the Examiner with excerpts from the Internet showing the common usage of the term to describe certain fabrics. These excerpts clearly demonstrate that one of ordinary skill in the art would (1) understand the term at issue; and (2) readily be able to produce the garments of the present invention without any undue experimentation.

The Examiner's attention is also directed to U.S. Patent No. 4,663,784 which shows a palm portion formed from a non-stretch fabric material (see column 1, lines 10 - 11) and to U.S. Patent No. 4,357,714 that is directed to an article that is formed in part from a woven non-stretch fabric (see the Abstract). Copies of these patents are enclosed herewith.

Applicant notes that the Examiner in making this rejection does not aver that the garments of the present invention could only be made with a significant amount of experimentation. Thus, as a matter of law, the Examiner has not made out a case of a lack of enablement. *Id.*

Instead, the Examiner argues that the specification does not provide enablement for "defining" a non-stretch fabric material. It is submitted that the Examiner misunderstands the enablement requirement. The enablement requirement does not require one of ordinary skill in the art to "define" the terms

used in the specification. In the instant case, the evidence introduced by Applicant shows that the term at issue requires no definition and would be readily understood by those skilled in the art because it is commonplace. The Examiner provides no evidence to the contrary. The Examiner's arguments are not a substitute for evidence.

The Examiner also avers that the specification does not define what the non-stretch material is made out of. The enablement requirement does not require Applicant to provide examples of non-stretch material in the specification. The sole issue on enablement is whether one of ordinary skill in the art could practice the claimed invention without undue experimentation. *Id.* As noted before, the Examiner has offered no explanation, in light of the evidence produced by Applicant, as to why the claimed invention could not be practiced by one of ordinary skill in the art.

With regard to the Examiner's comments on pages 5 and 6 of the final rejection, the fact remains that there are a group of materials known by those skilled in the art as "non-stretch fabric materials." This is best demonstrated by the aforementioned U.S. patents. Those skilled in the art can select and use any of the known non-stretch fabric materials. It does not matter that the terms are broad, they have a very definite meaning in the art. The fact that different garments have different needs and variables is irrelevant to the discussion of enablement. The case law does not rule out all experimentation, just undue experimentation.

With regard to the rejection of claims 10 - 13 on anticipation grounds over Kratz because Kratz lacks an outer elbow portion formed from a non-stretch fabric material. Kratz

relates to a motorcycle garment which has vent portions to maximize cooling. The jacket shown in FIGS. 2 and 3 of Kratz has mesh underarm portions, a mesh inner elbow portion, and mesh portions on the front and back of the jacket. As pointed out in column 5, line 44 et seq., the vents are shaped and position to provide maximum air flow utilizing those areas of the jacket which are least likely to come into abrasive contact with the pavement or other surface during an accident. The elbow vents are provided at the cyclist's inner elbows, because these areas are rarely abraded. To provide adequate protection, the back of the jacket is fabricated from an abrasion resistant material. The only mention of a flexible cloth mesh is for the element 116 which is provided to keep out bugs or other debris which might otherwise pass through the scoop 106. While Kratz says that the jacket may be constructed from natural or artificial leather, Kratz is totally silent as to whether either of these materials is stretchable or non-stretchable. This is because Kratz is indifferent on the subject.

Claim 10 is allowable because Kratz does not teach or suggest forming an outer elbow portion from a stretchable fabric material. Claim 10 is further allowable because Kratz never says that other portions of the arms are formed from a non-stretch fabric material and never says that the underarm portions are

formed from a stretch fabric material. The Examiner's position on these latter points is without any foundation in Kratz. The Examiner assumes that the stretch fabric is used throughout Kratz, but Kratz does not say that. It is not inherent that the mesh of Kratz has any stretch. The sole purpose of the mesh is to provide ventilation which can be accomplished with a non-stretch mesh material. Similarly, the Examiner's statements about the construction of the artificial leather is without foundation in Kratz. If one looks at the stretch marks on the embodiment of FIG. 8, it appears to Applicant that the non-mesh portions of Kratz' jacket are intended to stretch.

With regard to the Examiner's inherency argument, an element of a claim is not inherent in the disclosure of a prior art reference unless extrinsic evidence clearly shows that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by mere probabilities or possibilities. Further, mere fact that certain thing may results from a given set of conditions is insufficient to establish inherency. See *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Examiner has provided no extrinsic evidence to show inherency. Thus, the Examiner's arguments on pages 6 and 7 of the office

action does not comply with the requirements of the existing case law. Even if the Examiner is right about the composition of artificial leather, there is no evidence in support of the statement. There is also nothing which indicates that it is a composition being used by Kratz. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention. See *Atlas Powder Co. v. IRECO Inc.*, 51 USPQ2d 1943, 1945 - 46 (Fed. Cir. 1999). Kratz does not disclose the artificial leather described by the Examiner.

Claims 11 - 13 are allowable for the same reasons as claim 10 as well as on their own accord.

The rejection of claims 14 - 19 on obviousness grounds are duly noted. However, the secondary references to Blauer et al. and Lipson do not overcome the above-noted deficiencies of Kratz.

For the foregoing reasons, the instant application is believed to be in condition for allowance. Such allowance is respectfully solicited.

Should the Examiner believe an additional amendment is needed to place the case in condition for allowance, she is hereby invited to contact Applicant's attorney at the telephone number listed below.

A Notice of Appeal is enclosed herewith in the event that the Examiner maintains the rejections of record. Also enclosed herewith is a check in the amount of \$500.00 for the Notice of Appeal Fee. Should the Commissioner determine that an additional fee is due, he is hereby authorized to charge said fee to Deposit Account No. 02-0184.

Respectfully submitted,

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I, Nicole Motzer, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on July 11, 2005.

